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Remarks

Applicants thank the Examiner for his careful consideration of the application.

Claims 1 – 21 stand rejected.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1 - 3, 6 – 9, 16 - 18 and 20 under 35 USC § 103(a) as being unpatentable over Microsoft Word 2000 ("Word") in view of US Patent No. 6,676,309 to Shima ("Shima"). Applicants have canceled claim 3 and the limitation of claim 3 has been added to claim 1. Applicants respectfully traverse the remaining rejections.

In claim 1, Applicants recite a print driver user interface method for printing a document. The method includes receiving a number corresponding to a plural number of copies of the document to be printed from a software application, receiving at least one command relating to an operation to be performed on each of the plural number of copies of the document to be printed, displaying a first feature to a user in response to receiving a plural number of copies of the document to be printed, offering the user a choice to select to transfer control of printing the copies from the software application to the print driver, and transferring control of printing the number of copies from the software application to the print driver.

Claim 1 should be allowed as the Examiner has not established a prima facie case of obviousness. In order to sustain an obviousness rejection under 35 USC § 103(a), the Examiner must show that a combination of the cited references teach or suggest all the limitations of the claim being rejected. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that the combination of references teaches or suggests all the limitations of claim 1. Specifically, for example, the Examiner has not shown where either of the references discloses offering the user a choice to select to transfer control of printing the copies from the software application to the print driver, and transferring control of printing the number of copies from the software application to the print driver. The Examiner asserts that this is shown in column 7, lines 7 – 12 of Shima. However, this passage appears to state that when a user selects OK, "the print driver body obtains the

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name of application, the name of document, the attribution information and the inputted user information and produces a control command." (References omitted.) This passage does not mention transferring control of the number of copies to be printed from the application interface to the print driver UI at all. Further, Applicants have amended claim 1 to recite the limitation of claim 3 that the user is offered a choice of whether to transfer this control. There appears to be no such offer in this passage as well. Therefore, the Examiner's rejection should be withdrawn and claim 1 should be allowed.

Claims 2 and 6 – 9 should be allowed if claim 1 is allowed as claims 2 and 6 – 9 depend from claim 1.

Claim 9 should further be allowed because the Examiner has not shown that any of the cited references discloses reporting to the software application that one copy will be printed, while proceeding to print the plural number of copies received from the software application.

In claim 16 Applicants recite a print driver UI method for printing multiple copies of a document. The method includes offering the user one or more choices relating to printing multiple copies of the document, transferring control of printing the multiple copies from a software application to the print driver, and reporting to the software application that one copy of the document will be printed, while printing multiple copies of the document.

Claim 16 should be allowed as the Examiner has not established a prima facie case of obviousness. In order to sustain an obviousness rejection under 35 USC § 103(a), the Examiner must show that a combination of the cited references teach or suggest all the limitations of the claim being rejected. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that the combination of references teaches or suggests all the limitations of claim 16. Specifically, for example, the Examiner has not shown where either of the references teaches reporting to the software application that one copy of the document will be printed, while printing multiple copies of the document. Therefore claim 16 should be allowed.

Claims 17, 18, and 20 should be allowed if claim 16 is allowed as claims 17, 18, and 20 depend from claim 16.

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The Examiner rejected claims 4, 5, 10 – 16, 19 and 21 under 35 USC § 103(a) as being unpatentable over Word in view of Shima, and further in view of US Patent No. 6,762,852 to Fischer ("Fischer"). Applicants respectfully traverse these rejections.

Claim 4 should be allowed as the Examiner has not established a prima facie case of obviousness. Claim 4 recites all the limitations of claim 1, plus further recites permitting the user to select there is a problem printing multiple copies. For the reasons given with respect to claim 1, claim 4 should be allowed. Specifically, for example, the Examiner did not show that the combination of Word and Shima disclosed offering the user a choice to select to transfer control of printing the copies from the software application to the print driver, and transferring control of printing the number of copies from the software application to the print driver. The Examiner has also not identified these limitations in Fischer. Further, the Examiner has not shown that Fischer discloses permitting the user to select there is a problem printing multiple copies. The Examiner asserts that this feature is disclosed at the bottom of column 4 and ending at the top of column 5. This passage recites informing the user that a selected printer will not be able of printing using all the selected features and prompting the user whether printing should continue. This is not the same as permitting the user to select that there is a problem printing multiple copies. The machine described in Fischer tells the user that there is a problem printing multiple copies and asks the user whether printing should continue.

Claim 5 should be allowed as the Examiner has not established a prima facie case of obviousness. Claim 5 recites all the limitations of claim 1, plus further recites wherein the first feature informs the user that the software application may have a problem printing multiple copies. For the reasons given with respect to claim 1, claim 5 should be allowed. Specifically, for example, the Examiner did not show that the combination of Word and Shima disclosed offering the user a choice to select to transfer control of printing the copies from the software application to the print driver, and transferring control of printing the number of copies from the software application to the print driver. The Examiner has also not identified these limitations in Fischer. Therefore, claim 5 should be allowed.

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In claim 10, Applicants recite a print driver UI method for printing copies of a document. The print driver method includes receiving a plural number corresponding to the number of copies to be printed from a software application, receiving at least one command relating to an operation to be performed on each of the plural number of copies to be printed, and displaying a feature to a user informing the user that the software application may have a problem printing multiple copies.

Claim 10 should be allowed as the Examiner has not established a prima facie case of obviousness. In order to sustain an obviousness rejection under 35 USC § 103(a), the Examiner must show that a combination of the cited references teach or suggest all the limitations of the claim being rejected. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to show that the combination of references teaches or suggests all the limitations of claim 1. Specifically, for example, the Examiner has not shown where any of the references discloses displaying a feature to a user informing the user that the software application may have a problem printing multiple copies. The Examiner asserts that this is shown in Fischer. However, the passage cited by the Examiner appears to state that when a computer determines that none of the printers on a network include all the features in a job, then a warning message is presented to the user and the user chooses whether to proceed or not. This passage does not mention informing the user that the software application may have a problem printing multiple copies at all. In Fischer the device determines that there is a problem and asks the user whether he wants to proceed or not. Claim 4 informs the user that there may be a problem with printing multiple copies, a very specific message. Therefore, the Examiner's rejection should be withdrawn and claim 1 should be allowed.

Claims 11-15 should be allowed if claim 10 is allowed as claims 11 – 15 depend from claim 10.

Claim 19 should be allowed as the Examiner has not established a prima facie case of obviousness. Claim 19 recites all the limitations of claim 16, plus further recites permitting the user to select there is a problem printing multiple copies. For the reasons given with respect to claim 16, claim 19 should be allowed. Specifically, for example, the Examiner has

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not shown where either of the references teaches reporting to the software application that one copy of the document will be printed, while printing multiple copies of the document. The Examiner has also not identified these limitations in Fischer. Therefore, claim 19 should be allowed.
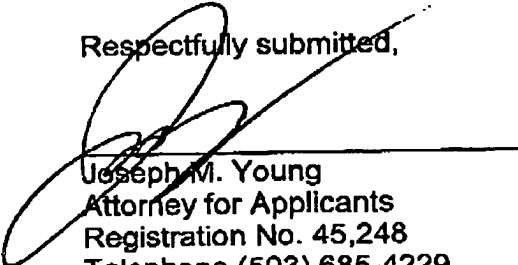
In response to the rejection of claim 21, please see Applicants' arguments with respect to claims 1, 4, 10, and 16 above. Based upon the arguments made in those sections, claim 21 should be allowed.

Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

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